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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,848	09/25/2001	Ronald G. French	509152000500	9332

20350 7590 07/23/2004

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT PAPER NUMBER

3738

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/963,848	<b>Applicant(s)</b> FRENCH ET AL.	
	<b>Examiner</b> Urmi Chattopadhyay	<b>Art Unit</b> 3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 24, 26-33, 36, 42-44, 46, 47, 50-86 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11, 20-22, 35 and 37-41 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 12-19, 23, 25, 34, 45, 48, 49 and 87-89 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on 6/30/04 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 09/963,848 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. The amendment filed 5/4/04 has been entered. The changes to Figure 22A and claims 1 and 22 have been approved by the examiner. Claims 91-95 have been canceled. Claims 1-90 are pending; claims 24, 26-33, 36, 42-44, 46, 47, 50-86 and 90 remain withdrawn from consideration; claims 1-23, 25, 34, 35, 37-41, 45, 48, 49 and 87-89 are being considered for further examination on the merits.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: on line 6, --substantially-- should be inserted before "non-elastic". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-22, 35 and 37-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 20 and 21 are indefinite because it is unclear if "the polymeric material" is referring to the interior surface, the exterior surface or both? It appears that it is referring to the exterior surface, and will so be interpreted for examination purposes. The examiner suggests inserting --exterior surface-- before "polymeric".

6. Claims 35 and 37-41 are indefinite because it is unclear if the inner and outer members are separate from and additional to the adjacent layers of claim 1 or if the inner and outer members are further limiting the adjacent layers. It appears, specifically from claim 38, that the inner and outer members are referring to the adjacent layers, but clarification of the claims is required without adding new matter.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1-8, 11, 35 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30, 34 and 36-39 of U.S. Patent No. 6,695,769. Although the conflicting claims are not identical, they are not patentably distinct from each other because the above listed patent claims include all the limitations of the listed application claims, and the claimed invention of the application is broader in scope than that of the patent. Both application and patent claim an enclosure generally conforming in shape to at least a portion of the heart (epicardium) and including a compliant and substantially non-elastic (flexible) member having an interior surface tending to inhibit adhesions with the epicardium and an exterior surface (webbing) for attachment to the interior of the pericardium. The member comprises more than one adjacent layers of material contiguous across the interior and exterior surfaces (non-adherent material is laminated to at least one other layer in the flexible member).

***Allowable Subject Matter***

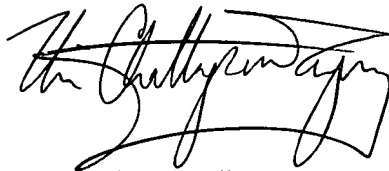
9. Claims 9, 10, 12-19, 23, 25, 34, 45, 48, 49 and 87-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 20-22, 37, 38, 40, 41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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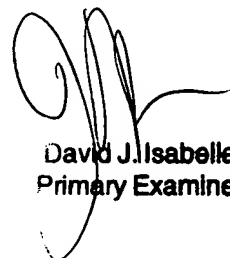
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 872-9306. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

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David J. Isabella  
Primary Examiner